

REMARKS

I. Status of Claims

Claims 1-16 are currently pending, and stand rejected. Claims 1, 2, 5, 14 and 16 have been amended. Claim 3 has been cancelled without prejudice or disclaimer. Claims 1 and 2 have been amended to recite the list of metal catalysts found in now cancelled claim 3, and to delete the term "derivative". Claim 2 has been further amended to define the solid acid catalyst as a sulfonate-substituted resin. Claim 5 has been amended to correct a now incorrect dependency. Claim 14 has been amended to define the solid acid catalyst as a sulfonate-substituted resin and to delete the term "derivative". Claim 16 has been amended to define the acid catalyst as listed in the instant claim 12.

No new matter has been added.

II. Claim Rejections

a) Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 1-2, 4 and 6-13 stand rejected for lack of enablement. The Examiner contends that the specification, while being enabled for nickel, palladium, platinum, rhodium, iridium, ruthenium and osmium as the metal catalysts, does not provide enablement for metal catalysts generally. Without conceding the correctness of the Examiner's position or the need for amendment, applicants have amended claims 1 and 2 to include the limitation found in the now cancelled claim 3 which lists the metals the Examiner asserts are enabled. Claims 4 and 6-13 depend from claims 1 and 2 directly or indirectly. Applicants respectfully request reconsideration and withdrawal of this rejection.

Claim 16 stands rejected for lack of enablement. The Examiner contends that the specification, while being enabling for formic, oxalic, malic, acetic, nitric, sulfuric, phosphoric and hydrochloric acids, does not provide enablement for acidic catalysts generally. Without conceding the correctness of the Examiner's position or the need for amendment, applicants have amended claim 16 to include the limitation found in claim 12 which lists the acids the Examiner asserts are enabled. Applicants respectfully request reconsideration and withdrawal of this rejection.

Claims 2 and 14 stand rejected for lack of enablement. The Examiner contends that the specification, while being enabled for a sulfonate-substituted resin as a solid acid catalyst, does not reasonably provide enablement for all kinds of solid acid catalysts known in the art. Without conceding the correctness of the Examiner's position or the need for amendment, applicants have amended claims 2 and 14 to recite the solid acid catalyst to be a sulfonate-substituted resin. Applicants respectfully request reconsideration and withdrawal of this rejection.

b) Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 1-16 stand rejected as being indefinite. The Examiner contends that the term "derivative" is vague and indefinite, since the specification does not provide a description for the term "derivative". Without conceding the correctness of the Examiner's position or the need for amendment, the term "derivative" has been deleted from claims 1, 2 and 14. Applicants respectfully request reconsideration and withdrawal of this rejection.

The Examiner further contends that, in claims 1, 2 and 14, the phrases "R represents linear, cyclic alcohols or aryl groups of from 1 to 10 carbon atoms" and "carboxylic acid with a linear

cyclic alkyl or aromatic alcohol having 1 to 10 carbon atoms” is vague and indefinite, since a cyclic group requires a minimum of 3 carbon atoms. Applicants respectfully traverse. In order to comply with 35 U.S.C. § 112, Second Paragraph, the scope of the subject matter embraced by the claim must be clear (“metes and bounds,” see M.P.E.P. § 2173.04). In this case, one of ordinary skill would immediately know that any cyclic group requires a minimum of three members, since cyclic structures having one or two members are impossible. It is therefore contended that the metes and bounds of the subject matter embraced by the claim is clear, and therefore satisfies 35 U.S.C. § 112, Second Paragraph. Applicants respectfully request reconsideration and withdrawal of this rejection.

c) Rejections Under 35 U.S.C. § 102(a)

Claims 1, 7, 9, 12 and 14 stand rejected as anticipated in view of Kwak et al. (WO 02/10147). Without conceding the correctness of the Examiner’s position or the need for amendment, independent claim 1 has been amended to include the limitation found in now cancelled claim 3 which is not anticipated by Kwak. Claims 7, 9, 12 and 14 all depend from claim 1. Applicants respectfully request reconsideration and withdrawal of this rejection.

